

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Berkey et al.

Serial No.: 10/085,798

Filing Date: 2/26/02

Title: BROADBAND ACCESS
OPTIMIZED FIBER AND METHOD
OF MAKING

**AFFIDAVIT OF
ROBERT L. CARLSON**

Group Art Unit: TBA

Examiner: TBA

Assistant Commissioner for Patents
Washington, DC 20231

STATE OF NEW YORK
COUNTY OF STEUBEN

ROBERT L. CARLSON, being duly sworn, and having personal knowledge of the facts set forth herein, hereby deposes and says that:

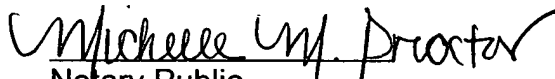
1. I am employed as Patent Portfolio Manager and Sr. Patent Attorney at Corning Incorporated, of Corning, New York.
2. Together with three (3) other inventors, Yanming Liu of 3 Granger Pond Way, Lexington, MA 02420, developed a Broadband Access Optical Waveguide Fiber disclosed and claimed in the accompanying Patent Application.
3. Before the patent application was completed and ready for execution, Yanming Liu left the employ of Corning Incorporated.
4. On May 17, 2002, Yanming Liu sent an e-mail to me (Exhibit G), indicating that once Corning agreed to compensate him appropriately, he would sign the Declaration and Assignment papers. On May 17, 2002, I telephone Yanming Liu to discuss signing the Declaration and Assignment papers for United States Application No. 10/085,798. He stated that he would not be willing to sign the documents until he was properly compensated. When I asked him what he meant by that, he indicated

that it would take him 15 minutes per page to review the application papers and that he should be paid \$300.00 per hour.

5. Yanming Liu's estimated salary while employed by Corning Incorporated was \$65.00 per hour.
6. On May 31, 2002 I called Yanming Liu and offered to compensate him at a rate of \$65.00 per hour at 5 minutes per page. He said this amount was "way too low". When I asked him if that was his final answer, he said "yes". (Exhibit H)


Robert L. Carlson

Sworn to before me this
2nd day of July, 2002.


Notary Public

Michelle M. Proctor
Notary Public, State of New York
Steuben County No. 4911462
Commission Expires Nov. 9, 20 05

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Title: BROADBAND ACCESS
OPTIMIZED FIBER AND METHOD
OF MAKING

**AFFIDAVIT OF
WILLIAM J. CHERVENAK**

Group Art Unit: TBA

Examiner: TBA

Assistant Commissioner for Patents
Washington, DC 20231

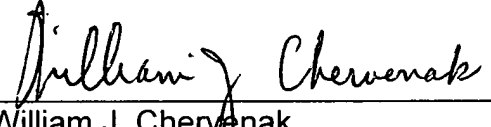
STATE OF NEW YORK
COUNTY OF STEUBEN

WILLIAM J. CHERVENAK, being duly sworn, and having personal knowledge of the facts set forth herein, hereby deposes and says that:

1. I am employed as Patent Agent of Corning Incorporated, of Corning, New York.
2. Together with three (3) other inventors, Yanming Liu of 3 Granger Pond Way, Lexington, MA 02420, developed a Broadband Access Optical Waveguide Fiber disclosed and claimed in the accompanying Patent Application.
3. Before the patent application was completed and ready for execution, Yanming Liu left the employ of Corning Incorporated.
4. On or about April 12, 2002, I sent a certified letter to Yanming Liu, on behalf of Corning Incorporated, asking that he sign the enclosed Declaration and Assignment papers for U.S. Patent Application No. 10/085,798. A copy of the letter and the signed certified mail receipt are attached hereto as Exhibit B.
5. All efforts to persuade Yanming Liu to execute the application have been unsuccessful as is demonstrated in the record of telephone conversations and letters attached hereto as Exhibits B, C, D, E, F G and H.
6. As a condition of his employment, upon entering employment with Corning Incorporated, Yanming Liu signed an Agreement assigning his patent rights to

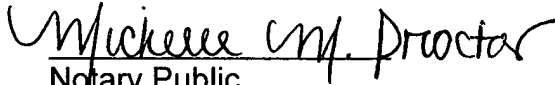
Corning and setting forth his duties and obligations regarding patenting of his work.
A copy of the Agreement is attached hereto as Exhibit A.

7. Yanming Liu verified he is in possession of the subject application and Declaration and Assignment papers as is set forth in Exhibit B.
8. Corning Incorporated recognizes the need to supply the access portion of the broadband telecommunications market. In light of the highly competitive nature of the telecommunications network market, it is necessary that Corning complete the application to protect Corning Incorporated's legitimate rights in the U.S. and foreign countries and to prevent irreparable damage resulting from the loss of these legitimate rights.



William J. Chervenak

Sworn to before me this
2nd day of July, 2002.



Notary Public

Michelle M. Proctor
Notary Public, State of New York
Steuben County No. 4911462
Commission Expires Nov. 9, 20 05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Berkey, et al
Serial No.: 10/085,798
Filed: 2/26/02
For: BROADBAND ACCESS OPTIMIZED
FIBER AND METHOD OF MAKING

**COMBINED
CERTIFICATE UNDER
37 C.F.R. § 3.73(b)
and
POWER OF ATTORNEY**

Assistant Commissioner for Patents
Washington, DC 20231

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

CORNING INCORPORATED, a New York corporation, certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of an assignment from the inventor(s) of the patent application identified above. A true copy of the unrecorded Assignment is attached hereto.

The undersigned has reviewed the above referenced assignment of the patent application identified above and, to the best of the undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned is empowered to sign this certificate on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Mr. Yanming Liu
3 Granger Pond Way
Lexington, MA 02420

April 12, 2002

RE: Application No. SP02-042
Broadband Access Optimized Fiber and Method of Making

 **CORNING**
Discovering Beyond Imagination

Dear Mr. Liu:

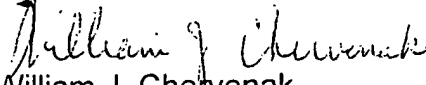
Enclosed herewith are the Declaration and Assignment papers for the above-referenced application, which was previously filed in the United States Patent and Trademark Office on February 26, 2002.

We have received a Notice to File Missing Parts from the Patent Office requiring that the enclosed documents be executed and filed in the Patent Office no later than June 2, 2002.

As such, please sign all of the enclosed documents where indicated and return them to me as soon as possible. Please note that we will have to obtain the signatures of the other inventors and therefore time is of the essence.

If you should have any problems or concerns, please feel free to contact me.

Very truly yours,


William J. Chervenak
Patent Agent

WJC/mmp
Enc.
REGISTERED MAIL
Return Receipt Request

To: File SP00-042

From: W. J. Chervenak

Date 13 May 2002

Subject: Signing of Assignment of Declaration Papers

Today I called Yanming Liu to discuss signing of the subject documents. He stated he could not discuss the matter, took my telephone number and stated he would call back.

To: File SP00-042

From: W. J. Chervenak

Date: 14 May 2002

Subject: Signing of Assignment of Declaration Papers

Today I called Yanming Liu to discuss signing of the subject documents. He had failed to return my telephone call of 13 May, 2002. He stated he was in possession of the application and the subject documents but was not yet prepared to sign them. I reminded him of our need to file the documents in the USPTO by 2 June 2002. He stated he was very busy and would have to study the papers further and consult an attorney before signing. I stated he had had the Assignment and Declaration papers since 17 April 2002 and asked why he had not yet taken action. He stated he was busy and the papers were not a priority matter for him. I stated we required the papers to be signed and returned to us by end of business 24 May 2002. I further stated we would file the application without his signature if he failed to return the signed documents.

During the course of our conversation, Dr. Liu said that his work had resulted in millions of dollars of profit for Corning and that he was not sure his work was appreciated. Now he was no longer employed by Corning but still the company was making demands on his time. He further stated that he still owned Corning stock and wanted the company to succeed.

Dr. Yanming Liu
3 Granger Pond Way
Lexington MA 02420

14 May 2002



Dear Dr. Liu:

We are in receipt of a certified mail receipt signed by you which shows that you received, on April 17, 2002, a copy of the Assignment and Declaration papers for the application having Attorney Docket No. SP00-042, United States Serial Number 10/085,798, filed in the United States Patent and Trademark Office (USPTO) on February 26, 2002. In our telephone conversation of 14 May 2002 you indicated that you have in your possession this copy of the subject application and Assignment and Declaration papers.

In the cover letter that was enclosed with the Assignment and Declaration papers, we indicated that we were required to file the executed documents in the USPTO by June 2, 2002 and asked that you sign and return the documents as soon as possible.

I called you May 13, 2002 and again May 14, 2002 to discuss this matter with you. In our telephone conversation of May 14, 2002, you indicated that you are not yet prepared to sign these documents despite the fact that you have had them in your possession since April 17, 2002.

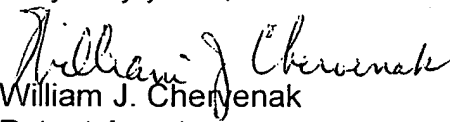
Therefore, we ask that you sign the Assignment and Declaration papers and return them to us no later than the end of business on May 24, 2002. Your failure to return the signed papers by May 24, 2002 will be viewed by us as a refusal on your part to sign the Assignment and Declaration papers, and we will proceed to file the papers under 37 C.F.R. §1.47.

Enclosed herewith is a copy of your Employee Patent and Proprietary Information Agreement with Corning Incorporated, dated August 30, 1993. I draw your particular attention to paragraph number 2 which states that you agree to *"...assign all such applications to the Company and its successors and assigns, and furnish such assistance and do all things, including the signing of necessary papers, as may be reasonably required of me to aid in the preparation and prosecution of such patent applications."*

It is my hope that you will honor the Agreement, sign the Assignment and Declaration papers and return them to me on or before May 24, 2002. I have enclosed a self addressed envelope for your use in returning the signed documents to me.

Please contact me at (607) 974-3956 if you should have any questions or concerns.

Very truly yours,


William J. Chervenak
Patent Agent

WJC/mmp
Enc.

To: File SP00-042

From: W. J. Chervenak

Date: 15 May 2002

Subject: Telephone Call from Y. Liu

On this date I received a call from Dr. Liu. He stated he had read the documents that need his signature and was concerned with the amount of time that would be required to fulfill his obligations. He said that if the work would take a few hours, he would do it, but if more time than that was required he would need to be compensated for his work. I stated that he was familiar with all the documents from previous signings and that he was familiar with the material in the applications. He disagreed and stated he felt a considerable amount of time would be required to read and understand the specification before he could properly sign. He did not want to begin work until he had a commitment that he would be compensated for any time he spent beyond a few hours. He had consulted with an attorney as to how he should handle the matter.

MEMO

TO: Yanming Liu File
FROM: Robert L. Carlson
DATE: May 31, 2002
RE: Compensation Issue

Today I had a telephone conference with Yanming Liu, and told him that Corning would be willing to compensate Yanming Liu at a reasonable hourly rate and for a reasonable time for him to review the documents and sign them. I asked Yanming what his yearly salary was, and he indicated that his base salary was \$130,000 per year. I then divided by 50 weeks and 40 hours per week and told him that I would agree to an hourly rate of \$65 per hour, and that this was fair because this would correspond to the hourly rate he was making when he was a scientist at Corning, and that we would allow him 5 minutes per page to review each application. He indicated he would not sign for this amount, and stated that "This is way too low." I asked him "Is this your final answer?" He said "Yes."

MEMO

TO: Li 2 U.S. Reissue File

FROM: R. L. Carlson

DATE: May 20, 2002

RE: Yanming Liu

Attached herewith is an Email that Bill Chervenak and I received from Yanming Liu on Friday, May 17th, 2002. I called Yanming later that day and told him that I had received his e-mail, and was calling to discuss.

He indicated that he would not be willing to sign either mine or Bill Chervenak's documents until he was properly compensated. I asked him what he meant by that, and he indicated that it would take him 15 minutes per page to review each of these documents, and that he should be paid an hourly rate of \$300 per hour to do so. I asked him why \$300 per hour and he said "because that's what patent attorneys get paid". (YM Liu made less than \$70/hour or less when he was a scientist working with Corning)

I then told him that the application I was asking him to sign a Declaration for was a reissue application, and that he had previously reviewed this application when it was originally filed and, therefore, the only new material would be the new claims we would be adding to the broadening reissue and therefore should not take long to review. His response was that he would still have to review the claims carefully and refer back to the specification very carefully to make sure that these documents were reviewed very carefully, and that it had been a long time since he had reviewed that application, so he would have to likely have to review it all again, as it had been a long time since he looked over these papers.

I told him that I would consider his request and get back to him.

Carlson, Robert L

From: YANMING LIU[SMTP:liuym@msn.com]
Sent: Friday, May 17, 2002 9:51 AM
To: carlsonrl@corning.com; chervenawj@corning.com
Subject: Patent Signiture

Robert L. Carlson
Patent Portfolio Manager
Optical Fiber

William Chervenak
Patent Agent

Dear Bob and Bill,

As I have told both of you, I agree to sign the "Combined Declaration ..." document with reference to "Reissue of US Patent 6,031,956" sent by Robert Carlson and Patent application entitled "BROADBAND ACCESS OPTIMIZED FIBER AND METHOD OF MAKING" sent me by William J. Chervenak. However, I need to review these documents carefully as required in the declaration.

As declared in the "COMBINED DECLARATION AND POWER OF ATTORNEY", "We have reviewed and understand the contents of the specification, including the claims, of the attached reissue application." "We believe ourselves to be the original, first, inventors of the subject matter...." In addition, in "DECLARATION IN ORIGINAL APPLICATION": "I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true." I need to review these documents carefully and thoroughly. If it is only a matter of an hour or so I will look over and sign it. However, there are more than 40 pages of current document need to be reviewed and unknown pages of related documents or subsequent documents may required to be reviewed also, it will take me substantially amount of work. I am seeking financial compensation regarding the work. Once you agree to compensate me appropriately, I will review the document, give your appropriate feedback and sign the documents.

Please contact me 781-589-6688 or email to me liuym@msn.com if you should have any questions or concerns.

Sincerely,

Yanming Liu

MSN Photos is the easiest way to share and print your photos:
<http://photos.msn.com/support/worldwide.aspx>